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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,296	08/31/2001	Manoel Tenorio	020431.0955	2038
53184 7590 10/03/2007 i2 TECHNOLOGIES US, INC. ONE i2 PLACE, 11701 LUNA ROAD DALLAS, TX 75234			EXAMINER JOHNSON, GREGORY L	
			ART UNIT 3691	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/945,296

Applicant(s)

TENORIO, MANOEL

Examiner

GREGORY JOHNSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1-32 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-5, 7, 9-15, 17, 19-25, 27, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over La Mura et al., Pat. No. 7,058,602 (hereinafter La Mura), and in view of Kinney Jr. et al., Pat. No. 6,871,191 (hereinafter Kinney), Wellman, Pat. No. 6,952,682 (hereinafter Wellman) and Johnson et al., Pat No. 6,598,029 (hereinafter Johnson) as set forth in the previous Office Action.

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5. Claims 6, 8, 16, 18, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over La Mura, Kinney and Wellman and as applied to claim 1, 11 and 21 above, and further in view of Walker et al., Pat. No. 7,039,603 (hereinafter Walker) as set forth in the previous Office Action.

Response to Arguments

6. Applicant's arguments filed July 20, 2007 have been fully considered but they are not persuasive.

Applicant argues (page 17, 2nd para.) that Kinney fails to disclose, teach or suggest the independent Claim 1 limitations:

- electronic marketplace
- in which there are generally fewer market participants associated with the first side than with the second side

In regards to an "electronic marketplace", Kinney teaches that a system and method can be used for conducting electronic online auctions (see Abstract). The Examiner has interpreted electronic online auctions as being an electronic marketplace. And in regards to the second limitation noted above, Kinney recites that in a supplier-bidding auction the auction marketplace has one buyer and many potential suppliers. The Examiner does acknowledge that Kinney uses the term "one-sided." However the fact that there is a buyer (i.e. buyer-side) and many suppliers (i.e. seller-side), the Examiner concludes that there are two sides. In addition, the buyer-side (i.e. first side)

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has fewer market participants than the seller-side (i.e. second-side). Therefore, Kinney does teach both of the above-mentioned limitations.

Applicant argues (page 18, 1st para.) that Wellman fails to disclose, teach or suggest the independent Claim 1 limitations:

- electronic marketplace
- prioritize among any offers associated with the first side that comprise equal offered prices and among any offers associated with the second side that comprise equal offered prices according to a predetermined prioritization scheme, the prioritization among such equally priced offers determining the order in which they are matched with other offers

In regards to an "electronic marketplace", Wellman teaches that a system and method can be used for conducting auctions (col. 3, lines 56-64 and Fig. 1). The Examiner has interpreted Wellman's auction system (also referred to as a market system) as being an electronic marketplace. And in regards to the second limitation noted above, the Wellman reference recites that when there are two or more matching pairs of bids of the buyer-seller pair, the market system may select one of the bids based upon predetermined or preset rules. Some of the examples given by Wellman include selection based on highest bid pair and earliest delivery date (col. 9, lines 25-34). These examples clearly show a prioritization is being conducted, in addition to being based on a predetermined or preset rules (i.e. a predetermined prioritization scheme). Therefore, Wellman does teach both of the above-mentioned limitations.

Applicant argues (page 18, 2nd para.) that Johnson fails to disclose, teach or suggest the independent Claim 1 limitation:

- each market participant associated with the first side generally having a greater market capacity than each market participant associated with the second side

In regards to this limitation, Johnson teaches that in an energy auction system there are energy suppliers and end users (i.e. first side and second side) (see Abstract and col. 9, lines 1 thru col. 10, line 67). It is clear to the Examiner that the energy suppliers have greater market capacity (i.e. they have more electric power or natural gas) than each market participant (i.e. end user) associated with the second side. Therefore, Johnson does teach the above-mentioned limitation.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, combining the references was done in order to address each limitation of the Applicant's claimed invention. Each of the references addressed different features/limitations found in electronic online auctions (i.e. electronic marketplace).

The motivation to use Kinney is based on the teachings that provided details about buyers and sellers (i.e. market participants) within an auction and the description of the auction process of matching buyers and suppliers so that transactions can take place electronically (col. 1, line 17 thru col. 2, line 65; and col. 4, line 28-55).

The motivation to use Wellman is based on the teaching of a clearing process (i.e. to settle the winning bid), which includes a technique for using predetermined rules (i.e. predetermined scheme) for selecting a winning bid (i.e. buyer) when two or more buyers have equal bids (col. 9, lines 25-34).

The motivation to use Johnson is based on the teachings that there can be different types of sellers and buyers (e.g. size, number, buying or selling capabilities) within an online auction (col. 5, lines 58-67). In addition, it would have been generally known to one of ordinary skill in the art of auctions, which always has two sides (i.e. buyer and seller), that one side can have more market capacity than the other side (as Johnson teaches). Therefore, this limitation is not novel.

The motivation to use Walker is based on the teachings that a settlement system can arrange for a buyer to purchase a product from a seller at a first price (i.e. matching seller's offer price with buyer's offer price) (col. 5, lines 10-36).

The limitations of independent claims 11, 21, 31 and 32 are equivalent to the limitations of independent claim 1, and are therefore rejected on the same grounds.

The rejection of claims 2-10, 12-20 and 22-30 remain as set forth in the previous Office Action.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571) 272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GREGORY JOHNSON

Examiner

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LALITA M. HAMILTON
PRIMARY EXAMINER